RECEIVED
CENTRAL FAX CENTER
OCT 15 2007

LAW OFFICES
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
3500 SunTrust Plaza
303 Peachtree Street, N.E.
Atlanta, Georgia 30308

Telephone
404-653-6400

Facsimile
404-653-6444

FACSIMILE TRANSMITTAL

DATE October 15, 2007

TO

Firm: U.S. Patent and Trademark Office **Fax No.:** 571-273-8300

FROM

Name: Christopher T. Kent **Phone No.:** 404-653-6559

Fax # Verified by: S. R. Horton **# Pages (incl. this):** 8

Confirmation Copy to Follow: No

SUBJECT
In re Application of: Vincent DE LAFORCADE
Application No. 10/808,568
Filed: March 25, 2004
For: COSMETICS PRODUCT
Attorney Docket No. 05725.0918-01

MESSAGE

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office on October 15, 2007.

By: _____
Christopher T. Kent
Reg. No. 48,216

Enclosed: Supplemental Response to Restriction and Election of Species Requirements (7 pages).

RECEIVED
CENTRAL FAX CENTER

OCT 15 2007

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0918-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Vincent DE LAFORCADE	Group Art Unit: 3733
Application No.: 10/808,568	Examiner: David C. Comstock
Filed: March 25, 2004	Confirmation No.: 4838
For: COSMETICS PRODUCT	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

VIA FACSIMILE

Sir:

SUPPLEMENTAL RESPONSE TO
RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

In reply to the Office Communication mailed September 20, 2007, Applicant respectfully submits that the Response to Restriction and Election of Species Requirements ("Response") filed June 29, 2007, is fully responsive to the Office Action of May 29, 2007. Nevertheless, by this Supplemental Response, Applicant has supplemented the previously filed Response, such that Applicant has more clearly provided a fully responsive reply to the Office Action of May 29, 2007.

In the Office Communication, it has been alleged that the Response "is not fully responsive to the . . . Office Action [of May 29, 2007]." Applicant respectfully submits that the allegation is improper because Applicant satisfied the requirements for making a fully responsive reply to the Office Action.

According to the M.P.E.P., the burden on Applicant when responding to restriction and election of species requirements is merely to provisionally elect one of the alleged groups of claims and one of the alleged species, and to identify the claims from the elected group that "read on" the elected species. M.P.E.P. § 818.03. If a provisional election and identification of claims are made, the reply is fully responsive, regardless of whether any traversal is allegedly incomplete. See § 818.03(b)-(c). In other words, even if the Examiner does not find a traversal to be persuasive, a reply is fully responsive as long as it includes a proper provisional election and claim identification.

In the Response filed June 29, 2007, Applicant provisionally elected, with traverse, to prosecute Group II, claims 40-95 and 169-224, and Species I (Fig. 1), and indicated that claims 40-95 and 169-224 "read on" Species I. Since the Response included provisional elections of an alleged group of claims and an alleged species, and identified the claims from the elected group that "read on" the elected species, the Response is fully responsive.

In response to the Office Action of May 29, 2007, and the Office Communication, Applicant once again provisionally elects, with traverse, to prosecute Group II, claims 40-95 and 169-224, and Species I (Fig. 1). Applicant respectfully submits that claims 40-95 and 169-224 "read on" Species I. By this provisional election, Applicant respectfully submits that this Supplemental Response is fully responsive to the Office Action of May 29, 2007, and the Office Communication of September 20, 2007.

Concerning traversal of the restriction and election of species requirements, the Examiner required an election under 35 U.S.C. § 121 of one of the following four (4) groups of claims:

I. Claims 96-134, allegedly drawn to "a clothing/compact combination";

II. Claims 40-95 and 169-224, allegedly drawn to "a business method";

III. Claims 135-145 and 225-235, allegedly drawn to "a method of making a compact"; and

IV. Claims 146-150 and 236-248, allegedly drawn to "a method of using an interface for choosing a visible aesthetic property."

In purported support of the above-outlined election requirement, the Examiner makes following distinctness allegations with respect to the groups:

1. Groups I and II are related as product and process of use;
2. Groups I and III are related a process of making and product made;
3. Groups I and IV are unrelated;
4. Groups II and III are unrelated;
5. Groups II and IV are unrelated; and
6. Groups III and IV are unrelated.

Applicant once again respectfully traverses the election requirement because at least the allegations 3-6, that Groups I, II, III, and IV are unrelated, are inaccurate. According to the M.P.E.P., two claims are unrelated only "if there is no disclosed relationship between the inventions, that is, they are unconnected in design, operation, and effect." § 806.06. To supply guidance, the M.P.E.P. provides examples of unrelated inventions, such as an article of clothing and a locomotive, and a process of

painting a house and a process for digging a well. § 806.06(A). Since the subject matter recited in each of Groups I-IV are disclosed as being related to one another, the Examiner's allegations about those groups of claims being unrelated are inaccurate.

For example, the claims of each of alleged Groups I-IV relate to a visible characteristic of a cosmetic product. Independent claim 96 of alleged Group I recites "a cosmetic product . . . , wherein a visible portion of the cosmetic product includes a second material . . . ." Independent claim 40 of alleged Group II recites "a cosmetic product having a visible aesthetic property . . . ." Independent claim 135 of alleged Group III recites a method of making a cosmetic case, including "attaching material to at least a portion of a blank constructed of foam, the material being chosen from fabric, imitation fabric, animal skin, and imitation animal skin . . . ." Independent claim 146 of alleged Group IV recites a method of customizing an appearance of a cosmetic product container. Because each of the claims of the alleged groups recites related subject matter as demonstrated by at least the above-identified subject matter, the alleged groups of claims are not unrelated in a manner such as provided in the examples in the M.P.E.P. (i.e., an article of clothing and a locomotive, and a process of painting a house and a process for digging a well). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the requirement for election between Groups I and IV, the election between Groups II and III, the election between Groups II and IV, and the election between Groups III and IV based on the inaccurate "unrelated" invention allegations.

In addition to the above-outlined requirement to elect one of the four groups of claims, the Examiner has also required election of one of the following two (2) alleged species (i.e., embodiments):

Species I, shown in Fig. 1 and

Species II, shown in Fig. 2.

The Examiner alleges that no claims are generic. Office Action at 5. Applicant respectfully traverses this allegation because at least independent claims 40, 54, 66, 78, 80, 90, 91, 96, 115, 120, 121, 122, 123, 129, 135, 146, 169, 182, 183, 195, 207, 208, 209, 219, 220, 225, 236, 241, and 245 are generic to both Figs. 1 and 2. Accordingly, Applicant respectfully requests reconsideration of the allegation concerning a lack of generic claims and requests confirmation that at least the above-listed independent claims are in fact generic to both of the exemplary embodiments shown in Figs. 1 and 2.

Applicant also respectfully notes that the Office Communication makes a number irrelevant and improper allegations. For example, the Office Communication implicitly alleges that the present application contains claims "coextensive in scope" with "parent application 09/902,265, now US Pat. No. 6,857,432," and implicitly forecasts rejecting them under 35 U.S.C. § 101 based on a double patenting allegation. Applicant respectfully submits that under USPTO rules of practice, the Office Communication is not a proper communication for making such vague, unsupported allegations to which Applicant has not been provided with a fair opportunity to respond appropriately. Further, Applicant respectfully requests that if the Examiner believes that such a claim rejection is proper, the Examiner include such rejection in an Office Action, as is proper

under the USPTO's rules of practice, so that Applicant will be provided with a fair opportunity to respond appropriately.

Further, the Office Communication alleges in a completely unsupported fashion that "it strains credulity that Applicant is the original, first, and sole inventor of some of the claimed subject matter," and "advise[s Applicant] to review the language in the Declaration and cancel any potentially overreaching claims." Applicant respectfully submits that these allegations are completely improper and contrary to USPTO rules of practice. Without question, Applicant is the original, first, and sold inventor of the claimed invention, and none of the claims has any overreach. If the Examiner continues to believe there is any issue of inventorship or claim scope, Applicant respectfully requests that the Examiner fully explain these purported issues and include any claim rejections in an Office Action, as is proper under the USPTO's rules of practice, so that Applicant will be provided with a fair opportunity to respond appropriately.

The Office Action and Office Communication contain a number of characterizations of the disclosure and the claims with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to automatically subscribe to any statement or characterization in the Office Action or Office Communication.

The Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559 if a telephone conversation would expedite the prosecution of the above-referenced application.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: October 15, 2007

By: _____
Christopher T. Kent
Reg. No. 48,216